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Response under 37 C.F.R. 1.116-
Expedited Procedure - Examining
Group Art Unit 1764

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Takagi et al.

Examiner: Wachtel, A.

Serial No.: 09/731,935

Group/Art unit: 1764

Filed: December 7, 2000

Docket: 188-84

For: METAL COATED FIBER MATERIALS Dated: May 1, 2003

Commissioner for Patents
United States Patent and Trademark Office
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PETITION UNDER 37 C.F.R. §1.181

Pursuant to 37 C.F.R. §1.181 and M.P.E.P §1002.02(c), it is respectfully petitioned that finality of the Office Action mailed February 25, 2003 (Paper No. 9) be withdrawn as premature, for the following reasons.

The previous Office Action mailed August 28, 2002 (Paper No. 6) by the Patent and Trademark Office in the above-identified application, substantively rejected pending Claims 1-18 in paragraph 2 on pages 2-3 thereof. Claim 19, which was pending at that time, was not rejected over any art in paragraph 2 of this Office Action.

The beginning of paragraph 2 of this Office Action reads, in pertinent part:

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Adjustment date: 07/31/2003 EEKUBAY1
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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope, addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: May 1, 2003

George M. Kaplan

Repln. Ref: 07/31/2003 EEKUBAY1 0009412600
DAH:041121 Name/Number:09731935
FC: 9204 \$130.00 CR

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,387,523 B2 to Bunyan et al in view of US 3,470,928 to Schwartz [emphasis added].

Claim 19 is not commented upon in paragraph 2 of the Office Action. Accordingly, Claim 19 was amended into independent form as Claim 20 in the amendment filed December 2, 2002 in the above-identified application.

The final Office Action mailed February 25, 2003 (Paper No. 9) substantively rejects Claim 20 in paragraph 3 at pages 2-4 thereof. Accordingly, a Request to withdraw finality of the Office Action was filed, under certificate of mailing, on April 3, 2003. In an Advisory Action mailed April 22, 2003, the Examiner declined to withdraw finality on the grounds that:

. . . Claim 19 was listed a rejected on form PTO-326 [of the previous Office Action, Paper no. 6]. Examiner intended for claim 19 to be explicitly rejected in the body of the first Office Action filed 8-28-2002. Given that the property limitations recited by claims 14 and 19 are identical, and considering that the text provided for the rejection of claim 14 would have been equally applied to claim 19, Examiner submits that Applicant would have reasonably seen that Examiner intended for claim 19 to be rejected [emphasis added].

It is respectfully emphasized that Applicants are not at all challenging the Examiner's right to reject the subject matter of prior Claim 19 (now independent Claim 20) over art; rather, Applicants simply contend that any rejection of this subject matter must appear in a nonfinal Office Action because the prior Office Action mailed August 28, 2002 (Paper No. 6) failed to reject this claim.

Concerning the statements in the Advisory Action mailed April 22, 2003 (Paper No. 11), it is even acknowledged by the Examiner that the prior Office Action mailed August 28, 2002 failed to explicitly reject Claim 19. The Examiner asserts Applicants would have reasonably seen Examiner intended to reject Claim 19, yet points out no location where Claim 19 was substantively treated on the merits (Summary Page PTO-326 does not substantively treat Claim 19). Concerning recitations found in Claims 14 and 19, it is respectfully pointed out that the scope of these two claims is different because these claims respectively depend from different claims.

If the Examiner now asserts he intends to reject the subject matter of Claim 19 (now Claim 20), then Applicants accept Examiner's contention and are prepared to address this rejection. However, it is respectfully asserted that such rejection must appear in a nonfinal Office Action because this claimed subject matter, which was previously presented, had not been rejected until issuance of the outstanding Office Action mailed February 25, 2003 (Paper No. 9).

Therefore, granting of the present Petition to withdraw finality of the outstanding Office Action is respectfully requested. A check in the amount of \$130 for the petition fee in accordance with 37 C.F.R. §1.17(h) is enclosed. Please charge any deficiencies or credit any overpayment to Deposit Account no. 04-1121 (two copies of this sheet are enclosed).

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "George M. Kaplan", is written over a horizontal line.

George M. Kaplan, Esq.
Reg. No. 28,375
Attorney for Applicant(s)

DILWORTH & BARRESE LLP.
333 Earle Ovington Blvd.
Uniondale, NY 11553
(516) 228-8484